

be better to file a completely new application which would include a description of the best mode. Each of the questions required a full explanation of the reasons for the answer.

Petitioner answered Question 2C stating that it would be better to file a new application. He then proceeded to describe how the filing should be accomplished.

This is best done by taking advantage of the file wrapper continuing procedure (37 CFR 1.62) with an additional claim covering the [best mode] embodiment not entitled to the earlier filing date of the previous application. It will then be necessary according to 37 CFR 1.62(c) that [the inventor] make an oath as required under 37 CFR 1.63 for the added disclosure and claim. The previously filed application is thus expressly abandoned (37 CFR 1.62(g)) and the new application will cover the previous invention plus [best mode] embodiment.

One point, out of a possible 10, was awarded for that answer for correctly indicating the preferred filing of a completely new application.

Petitioner requested and was provided a copy of his examination, which included remarks by the grader and model answers. He subsequently requested regrading by the Director of OED. With respect to Question 2C, petitioner asserted that he recognized a completely new application should be filed and elaborated why it was appropriate to file a continuing application under 37 CFR § 1.62. He also asserted that he was improperly penalized for proposing the addition of a new claim and for failing to state that a new application should be filed prior to a particular due date.

The Director of OED regraded the examination but did not award any additional points for the answer to Question 2C. The Director noted that use of 37 CFR § 1.62 would be improper since the prior application was not complete and therefore could not form the basis for a file wrapper continuation. The Director cited 37 CFR §§ 1.62(a); 1.51(a) and 1.71(b) in support of his position. The Director also noted that a complete answer to the question would have included recognition that a new application should be filed within one year of the date of public use described in the fact pattern.

III

Petitioner asserts that his answer was substantially correct and that seven or eight additional points should have been awarded. He asserts that his answer proposed submitting a completely new application and that the use of 37 CFR § 1.62 was the appropriate means to accomplish the result. Petitioner argues that all the requirements of 37 CFR § 1.51(a) were present in the original application, and it was therefore complete for the purposes of filing a "CIP application per se." He also asserts that the requirements of 37 CFR §§ 1.51(a) and (b) are separate, though interrelated,

from the requirements of 35 U.S.C. § 112, ¶1 and 37 CFR

§ 1.171(b). Petitioner contends

that nowhere in the statutes nor in the rules is there any basis for proscribing one's right to avail oneself of a Rule 62 CIP application filing mechanism to file per se an application whose parent application has not brought forth the best mode and to overcome this deficiency [with a file wrapper continuation].

Petitioner urges that it is appropriate to file a Rule 62 application while not intending to claim priority under 35 U.S.C. § 120. In a letter to the Commissioner dated June 6, 1990, petitioner suggests that Question No. 74 of the morning section of the April 1990 Examination for Registration to Practice illustrates the propriety of filing a CIP in order to overcome a deficiency under 35 U.S.C. § 112, ¶1.

IV

In reaching this decision, careful consideration has been given to Question 2 of the examination, petitioner's answers to all parts of Question 2, the grader's comments, petitioner's request for regrading, the Director's decision, the current petition, and Question No. 74 of the morning section of the April 1990 Examination for Registration to Practice.

Question 2C specifically asked whether filing a "completely new application" disclosing the best mode was a better approach than the two "strategies" proposed by Questions 2A and 2C. The question also required petitioner to "[e]xplain fully why such a strategy would be better than Strategies I and II". Petitioner was given one point for answering that

filing a new application would be better. However, he did not explain why that approach would be better.

As indicated in the model answer to Question 2, the first application did not meet the requirements of 35 U.S.C. § 112, ¶1, because it did not disclose the best mode. Thus, no valid patent could issue on that application. As further indicated in the model answer, of the three strategies, refiling is the only way the invention and the interests of the client could be protected. Petitioner's answers to Question 2 do not reflect recognition that the application was defective under § 112, necessitating the filing of a new application. Reference to the file wrapper continuation procedure of 37 CFR § 1.62 as a means to file a new case does not explain why filing a new case would be a better approach than the other two strategies.

Petitioner also failed to answer the question based upon the facts stated in the question. Question 2C specifically states that the claims of the new application were to be "identical in every respect to the original . . . application." In accord with the examination directions, points are to be deducted, inter alia, for failure to properly answer the question posed. Petitioner, in answering Question 2C, modified the fact pattern presented in the question.

Petitioner's answer to Question 2C indicates that an additional claim was necessary because the claims of the earlier application would not protect the best mode embodiment. This interpretation is not reasonable because of the phrase "segments comprises" in the last clause of claim 1 would encompass the best mode embodiment. Petitioner did not recognize that a new claim directed to the best mode embodiment was not necessary to protect the disclosed invention.


Petitioner also challenges any deduction of points based upon his failure to indicate that a new application must be filed within one year of a public use. A review of Question 2C indicates that the question does not require a response indicating when the new application had to be filed. Therefore, to the extent the Director deducted points for petitioner's failure to indicate the time frame for filing a new application, those points should be restored.

V

The petition is granted to the extent indicated above but is otherwise denied.

Date: _____

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and Trademarks

cc: